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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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Applicant	Huber, Steven A.
Applied for Mark	EARTH PETS NATURAL PET MARKET
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Steven A. Huber

Serial No. 86323047

Trademark: EARTH PETS NATURAL PET MARKET

Filing Date: June 27, 2014

BRIEF OF THE APPLICANT

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I. INTRODUCTION

COMES NOW the Applicant Steven A. Huber (hereinafter “Applicant”) and through counsel The Trademark Company, PLLC, and provides this Brief of the Applicant in support of its appeal of the examining attorney’s refusal to register the instant mark.

II. STATEMENT OF THE CASE

On or about June 27, 2014 Applicant filed the instant trademark with the U.S. Patent and Trademark Office seeking to register the same on in connection with the following services: "retail pet stores".

On or about October 7, 2014 the Examining Attorney refused registration of the Applicant’s trademark on the grounds that, if registered, it would create a likelihood of confusion



with the registered trademark and NATURAL PET MARKET more fully set forth in U.S. Registration Nos. 3351024 and 3621455. Of note, U.S.



Registration No. 3351024 for retains a disclaimer for the descriptive wording in the mark “NATURAL PET MARKET”. Moreover, U.S. Registration No. 3621455 claims acquired distinctiveness under Section 2(f), in part, for the term NATURAL but also retains a disclaimer for PET MARKET.

On or about April 7, 2015 Applicant filed a response to the Office Action dated October 7, 2014 arguing in support of registration. In large part, Applicant attempted to show that the only overlapping terms as between the marks were generic or highly descriptive as they relate to

the respective services of the parties and, as such, would not be viewed as source identifying material by the average consumer therefore allowing the services marks to co-exist in the marketplace without concern for a likelihood of confusion.

However, Applicant's argument was not deemed persuasive by the Examining Attorney and, accordingly, on or about April 28, 2015 the Examining Attorney made the refusal final. The instant appeal now timely follows.

III. ARGUMENT

The Standard for a Determination of a Likelihood of Confusion

A determination of likelihood of confusion between marks is made on a case- specific basis. *In re Dixie Restaurants Inc.*, 41 USPQ2d 1531, 1533 (Fed . Cir. 1997). The Examining Attorney is to apply each of the applicable factors set out in *In re E.I. du Pont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). The relevant *du Pont* factors are:

- (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression;
- (2) The similarity or dissimilarity and nature of the goods as described in an application or registration or in connection with which a prior mark is in use;
- (3) The similarity or dissimilarity of established, likely-to-continue trade channels;
- (4) The conditions under which and buyers to whom sales are made, i.e., 'impulse' vs. careful, sophisticated purchasing;
- (5) The number and nature of similar marks in use on similar services; and
- (6) The absence of actual confusion as between the marks and the length of time in which the marks have co-existed without actual confusion occurring.

Id.

The Examining Attorney is tasked with evaluating the overall impression created by the marks, rather than merely comparing individual features. *Mead Data Cent., Inc. v. Toyota Motor*

Sales, U.S.A., Inc., 875 F.2d 1026, 1029, 10 USPQ2d 1961 (2d Cir. 1989). In this respect, the Examining Attorney must determine whether the total effect conveyed by the marks is confusingly similar, not simply whether the marks sound alike or look alike. *First Savings Bank F.S.B. v. First Bank System Inc.*, 101 F.3d at 645, 653, 40 USPQ2d 1865, 1870 (10th Cir. 1996) (recognizing that while the dominant portion of a mark is given greater weight, each mark still must be considered as a whole)(citing *Universal Money Centers, Inc. v. American Tel. & Tel. Co.*, 22 F.3d 1527, 1531, 30 USPQ2d 1930 (10th Cir. 1994)). Even the use of identical dominant words or terms does not automatically mean that two marks are confusingly similar. In *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627, 3 USPQ2d 1442 (8th Cir. 1987), the court held that “Oatmeal Raisin Crisp” and “Apple Raisin Crisp” are not confusingly similar as trademarks. Also, in *First Savings Bank F.S.B. v. First Bank System Inc.*, 101 F.3d at 645, 653, 40 USPQ2d 1865, 1874 (10th Cir. 1996), marks for “FirstBank” and for “First Bank Kansas” were found not to be confusingly similar. Further, in *Luigino’s Inc. v. Stouffer Corp.*, 50 USPQ2d 1047, the mark “Lean Cuisine” was not confusingly similar to “Michelina’s Lean ‘N Tasty” even though both marks use the word “Lean” and are in the same class of services, namely, low-fat frozen food.

Concerning the respective goods with which the marks are used, the nature and scope of a party’s goods must be determined on the basis of the goods recited in the application or registration. *See, e.g., Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993); *J & J Snack Foods Corp. v. McDonald’s Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *Octocom Systems Inc. v. Houston ComputergoodsInc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811

F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (CCPA 1973). *See generally* TMEP § 1207.01(a)(iii).

Even if the marks are similar, confusion is not likely to occur if the goods in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create an incorrect assumption that they originate from the same source. *See, e.g., Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (cooking classes and kitchen textiles not related); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156 (TTAB 1990) (LITTLE PLUMBER for liquid drain opener held not confusingly similar to LITTLE PLUMBER and design for advertising services, namely the formulation and preparation of advertising copy and literature in the plumbing field); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668 (TTAB 1986) (QR for coaxial cable held not confusingly similar to QR for various products (*e.g.*, lamps, tubes) related to the photocopying field). *See generally* TMEP § 1207.01(a)(i).

Purchasers who are sophisticated or knowledgeable in a particular field are not necessarily immune from source confusion. *See In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983). However, circumstances suggesting care in purchasing may tend to minimize likelihood of confusion. *See generally* TMEP § 1207.01(d)(vii).

Applying the legal standards as enumerated above, it is clear that confusion is not likely as between Applicant's trademark and the trademark cited and, accordingly, the refusal to register EARTH PETS NATURAL PET MARKET should be withdrawn.

A. *The Services of the Service Marks Overlap*

As a threshold matter, Applicant must concede the similarity of the services as recited in the Applicant's applied-for trademark as well as the registered trademarks. Notwithstanding this concession, however, Applicant nevertheless submits that the remaining *du Pont* factors addressed herein, namely the lack of similarity of the service marks in conjunction with the lack of actual consumer confusion despite longstanding co-existence in the marketplace, establish that even despite the similarity in services and presumptively trade and marketing channels confusion is not likely.

B. *Overlapping Terms Descriptive*

If the common element of two marks is "weak" in that it is generic, descriptive, or highly suggestive of the named goods or services, it is unlikely that consumers will be confused unless the overall combinations have other commonality. *See, e.g., In re Bed & Breakfast Registry*, 791 F.2d 157, 159 229 USPQ 818, 819 (Fed. Cir. 1986) (reversing TTAB's holding that contemporaneous use of BED & BREAKFAST REGISTRY for making lodging reservations for others in private homes, and BED & BREAKFAST INTERNATIONAL for room booking agency services, is likely to cause confusion, because, inter alia, the descriptive nature of the shared wording weighed against a finding that the marks are confusingly similar); *U.S. Shoe Corp. v. Chapman*, 229 USPQ 74 (TTAB 1985) (holding COBBLER'S OUTLET for shoes, and CALIFORNIA COBBLERS (in typed and stylized forms) for footwear and women's shoes, not likely to cause confusion); *In re Istituto Sieroterapico E Vaccinogeno, Toscano "SCLAVO" S.p.A.*, 226 USPQ 1035 (TTAB 1985) (holding ASO QUANTUM (stylized, with "ASO" disclaimed) for diagnostic laboratory reagents, and QUANTUM I for laboratory instruments for analyzing body fluids, not likely to cause confusion).

See also Safer, Inc. v. OMS Invs., Inc., 94 USPQ2d 1031, 1044-45 (TTAB 2010) (holding DEER-B-GON for animal repellant used to repel deer, other ruminant animals, and rabbits, and DEER AWAY and DEER AWAY PROFESSIONAL for repellant for repelling deer, other big game, and rabbits, not likely to cause confusion, noting that “DEER” is descriptive as applied to the relevant goods and thus has no source-indicating significance); *Bass Pro Trademarks, L.L.C. v. Sportsman’s Warehouse, Inc.*, 89 USPQ2d 1844, 1857-58 (TTAB 2008) (finding that, although cancellation petitioner’s and respondent’s marks were similar by virtue of the shared descriptive wording “SPORTSMAN’S WAREHOUSE,” this similarity was outweighed by differences in terms of sound, appearance, connotation, and commercial impression created by other matter and stylization in the respective marks); *In re Shawnee Milling Co.*, 225 USPQ 747, 749 (TTAB 1985) (holding GOLDEN CRUST for flour, and ADOLPH’S GOLD’N CRUST and design (with “GOLD’N CRUST” disclaimed) for coating and seasoning for food items, not likely to cause confusion, noting that, because “GOLDEN CRUST” and “GOLD’N CRUST” are highly suggestive as applied to the respective goods, the addition of “ADOLPH’S” is sufficient to distinguish the marks); *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011) (affirming TTAB’s holding that contemporaneous use of applicant’s CAPITAL CITY BANK marks for banking and financial services, and opposer’s CITIBANK marks for banking and financial services, is not likely cause confusion, based, in part, on findings that the phrase “City Bank” is frequently used in the banking industry and that “CAPITAL” is the dominant element of applicant’s marks, which gives the marks a geographic connotation as well as a look and sound distinct from opposer’s marks); *In re S.D. Fabrics, Inc.*, 223 USPQ 54, 55-56 (TTAB 1984) (holding DESIGNERS/FABRIC (stylized) for retail fabric store services, and DAN RIVER DESIGNER FABRICS and design for textile fabrics, not likely

to cause confusion, noting that, because of the descriptive nature of “DESIGNERS/FABRIC” and “DESIGNER FABRICS,” the addition of “DAN RIVER” is sufficient to avoid a likelihood of confusion).

In the instant case, the service marks at issue share the same, weak, overlapping term(s), namely NATURAL PET MARKET. As evidence of this weakness, Applicant voluntarily disclaimed “NATURAL PET MARKET” apart from his service mark long ago. Moreover, the



cited service mark also retains a disclaimer of “NATURAL PET MARKET”. Finally, the cited trademark NATURAL PET MARKET retains a disclaimer of “PET MARKET” with the only basis for the mark being able to exist on the Principal Register is the submission of a Section 2(f) claim based upon use for the term NATURAL.

A holding affirming the refusal would be akin to holding COCA COLA SODA is too similar to PEPSI COLA SODA because the term SODA overlaps wherein both marks are used for soda. The law simply supports registration of marks wherein the sole overlapping term(s) are descriptive.

As the case law sets forth above, if the primary similarity as between the Applicant’s Trademark and that of the registrant are descriptive in nature, this consideration lends to a conclusion of an absence of a likelihood of confusion under *du Pont*.

C. The Service Marks Are Dissimilar

The points of comparison for a word mark are appearance, sound, meaning, and commercial impression. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee*

en 1772, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (citing *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973)). Similarity of the marks in one respect – sight, sound, or meaning – will not automatically result in a determination that confusion is likely even if the goods are identical or closely related. Rather, taking into account all of the relevant facts of a particular case, similarity as to one factor alone *may* be sufficient to support a holding that the marks are confusingly similar, but a similarity of one factor is not dispositive of the entire analysis. *See In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988). Additions or deletions to marks are often sufficient to avoid a likelihood of confusion if: (1) the marks in their entireties convey significantly different commercial impressions; or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted.

If the respective trademarks create separate and distinct commercial impressions source confusion is not likely. *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1245, 73 USPQ2d 1350, 1356-57 (Fed. Cir. 2004) (reversing TTAB’s holding that contemporaneous use of THE RITZ KIDS for clothing items (including gloves) and RITZ for various kitchen textiles (including barbeque mitts) is likely to cause confusion, because, *inter alia*, THE RITZ KIDS creates a different commercial impression).

In the instant case, Applicant’s trademark EARTH PETS NATURAL PET MARKET creates a commercial impression of a natural pet market for pets from Earth or land animals. The dominant portion of the mark is the suggestive EARTH PETS even though the term PETS is also disclaimed as being descriptive of the goods provided under the Applicant’s services. The weakest portion of the mark is the arguably generic but definitely highly descriptive NATURAL

PET MARKET which describes, if not is, exactly the services that are provided by the Applicant. Thus, the dominant portion of the mark, that which creates the commercial impression upon which consumers will look as a source identifier, is EARTH PETS.



In the alternative, the registered trademark contains the dominant element of the stylized design of a woman, cat, and dog. The design would be viewed as the dominant element as the other terms in the mark, NATURAL PET MARKET, as in the Applicant's service mark, are admittedly descriptive and disclaimed by the registrant. As such, when comparing these two marks on a side-by-side basis, the dominant elements are the design of the registered service mark and the EARTH PETS of the Applicant's service mark. In this respect, there is simply no overlap as between the two.

Turning to the registrant's standard character mark, its service mark is NATURAL PET MARKET with PET MARKET disclaimed and NATURAL having a Section 2(f) claim thereon. In this regard, the entire mark must be viewed as very weak having the disclaimer of PET MARKET, generic for the services, and an alleged acquired distinctive component of NATURAL. Notwithstanding this claim of acquired distinctiveness, this mark is still weak and lacks the distinctive component EARTH found in the Applicant's trademark which creates a completely separate and distinct commercial impression apart from the registered mark that does not contain any naturally non-descriptive term therein.

As such, given these separate and distinct commercial impressions, it is submitted that this fact favors a finding of an absence of a likelihood of confusion under this *du Pont Factor*.

D. Absence of Actual Confusion

Finally, there is no evidence of record indicating that there has been actual confusion in the marketplace as between Applicant's services and the registrant's services.

The absence of any instances of actual confusion is a meaningful factor where the record indicates that, for a significant period of time, an applicant's sales and advertising activities have been so appreciable and continuous that, if confusion were likely to happen, any actual incidents thereof would be expected to have occurred and would have come to the attention of one or all affected trademark owners. *See Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992).

As the Examining Attorney has alleged, the Office believes that the Applicant's services and those of the registered trademark travel in similar trade channels and are marketed in a similar enough manner to create a likelihood of confusion. While not conceding this point, provided that this is, in fact, the Office's position it would be contradictory to discount the absence of actual confusion as between the trademarks at issue where the Office contends there is an overlap in marketing and trade channels.

Specifically, the respective service marks have co-existed in the marketplace for in excess of 13 years. If a likelihood of confusion is of concern is it not probably that in these 13 years there would have been some actual confusion?

Accordingly, consistency in the Office's position, whether or not countered by the Applicant in the instant Argument, suggests that the Office should consider the absence of evidence of actual confusion and, in this case, the significant time of 13 years of co-existence without any evidence of actual confusion, to be a very meaningful factor in the instant analysis, a

factor which clearly supports registration of Applicant's Trademark under this *du Pont* factor (*emphasis added*).

V. CONCLUSION

Based upon the foregoing it is submitted that the *du Pont* factors addressed herein favor registration of the Applicant's Trademark.

WHEREFORE it is respectfully requested that the Trademark Trial and Appeal Board reverse the decision of the Examining Attorney, remove as an impediment the cited trademark, and approve the instant Application for publication.

Respectfully submitted this 28th day of December, 2015,

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